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Dan Vassilovski

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EXAMINER

WOOD, WILLIAM H

ART UNIT

PAPER NUMBER

2193

NOTIFICATION DATE

DELIVERY MODE

02/19/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com  
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### **DETAILED ACTION**

Claims 1-8 and 21-24 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21 and 22 encompass software *per se* by reciting “means for” limitations, which based upon the specification includes software elements and no hardware elements (as all means are possibly claimed). Claims 23 and 24 encompass non-tangible “signal” media (Specification: page 4, lines 20-21), which is non-statutory.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 2-3, 6, 22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Shaw** (USPN 6,381,741).

#### Claim 2

**Shaw** disclosed a method for configuration management for a computing device (*Abstract*), comprising:

- ♦ providing available software to be loaded into said computing device to said computing device through an interface (*Figure 1, elements 50 and 70; column 2, lines 58-67; column 1, line 65 to column 2, line 10*);
- ♦ determining whether or not resident software stored in a storage device associated with said computing device is authenticated (*column 3, lines 40-65; Figure 2*);
- ♦ determining whether or not said available software is authenticated (*column 4, line 6 to column 7, line 46; column 5, lines 34-41*);

- ♦ rejecting said available software if said resident software is authenticated and said available software is not authenticated (*column 3, line 66 to column 4, line 3; column 5, lines 34-41*); and
- ♦ updating said resident software with said available software if one of the following three conditions is met:
  - (1) said resident software is authenticated and said available software is authenticated (*column 3, line 58-65; Figure 2; forced update*).
  - (2) said resident software and said available software are not authenticated (*at least above condition 1 met*),
  - (3) said resident software is not authenticated but said available software is authenticated (*at least above condition 1 met*).

### Claim 3

**Shaw** disclosed the method of claim 2 (as discussed above) wherein said determining whether or not said resident software is authenticated comprises:

- ♦ determining whether or not an authentication flag has been set (*column 3, lines 45-57*);
- ♦ wherein said resident software is determined to be authenticated if said authentication flag has been set (*column 3, lines 48-50*); otherwise

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- ♦ said resident software is determined to be unauthenticated (*column 3, lines 48-50*).

Claim 6

**Shaw** disclosed the method of claim 2 wherein said determining whether or not said resident software is authenticated comprises of performing a direct authentication procedure on said resident software (*column 3, line 66 to column 4, line 5*).

Claims 22 and 24

The limitations of claims 22 and 24 correspond to claim 2 and as such are rejected in the same manner.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-5, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shaw** (USPN 6,381,741).

Claim 1

**Shaw** disclosed a method for configuration management for a computing device  
(*Abstract*), comprising:

- ♦ providing available software to be loaded into said computing device to update a resident software within said computing device (*Figure 1, elements 50 and 70; column 2, lines 58-67; column 1, line 65 to column 2, line 10*);
- ♦ determining whether or not resident software stored in a storage device associated with said computing device is authenticated (*column 3, lines 40-65; Figure 2*);
- ♦ determining whether or not said available software is authenticated (*column 4, line 6 to column 7, line 46*);
- ♦ updating said resident software with said available software if said resident software and said available software are not authenticated (*column 3, lines 45-58, system determines resident software corrupt and needs update; as shown above available software is also checked for authenticity*);
- ♦ updating said resident software if said resident software is not authenticated but said available software is authenticated (*column 5, lines 34-41, no requirement to authenticate resident software here; further column 3, lines 45-58, sometimes update regardless of “TrustData” bit, for example if “RunDownloader” is set*)

**Shaw** did not explicitly state setting an authentication flag if said resident software is not authenticated but said available software is authenticated.

**Shaw** demonstrated that it was known at the time of invention to make use of flag indicators (column 3, lines 45-57; and column 4, line 45) and **Shaw** (as shown above) clearly demonstrates authenticating available code segments. It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of **Shaw** with a method of recording available code is authenticated (a flag) as found in **Shaw**'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to make use of a common method/device (flag) of communicating/recording information (in this case is or isn't code authenticated). This action occurs regardless of whether resident software is or is not authenticated.

Claim 4

**Shaw** disclosed the method of claim 3 wherein said authentication flag is set when said available software is determined to be authenticated (*as above under claim 1*).

Claim 5

**Shaw** disclosed the method of claim 4 wherein said authentication flag is set by a service technician (*column 3, lines 55-65*).

Claims 21 and 23

The limitations of claims 21 and 23 correspond to claim 1 and as such are rejected in the same manner.

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shaw** (USPN 6,381,741) in view of admitted prior art (herein referred to as **APA**).

Claims 7 and 8

**Shaw** disclosed the method of claim 6 (as discussed above). **Shaw** did not explicitly state: wherein said direct authentication procedure comprises performing a cyclic redundancy check; or wherein said direct authentication procedure comprises performing a secure hashing algorithm. **APA** demonstrated that it was known at the time of invention to utilize cyclic redundancy check, CRC (Specification, page 5, lines 24-35) and secure hashing algorithms, SHA (Specification, page 5, lines 24-35). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of **APA** into the system and method of **Shaw**. This implementation would have been obvious because one of ordinary skill in the art would be motivated to perform well-known authentication techniques to



determine when an update was necessary in order to improve the performance of a computing system.

### ***Response to Arguments***

8. Applicant's arguments filed 17 January 2008 have been fully considered but they are not persuasive.

Applicant argues **Shaw** does not disclose, “determining whether or not said resident software stored in a storage device associated with said computing device is authenticated”. Reviewing **Shaw** (column 3, lines 48-54), it is clear the cited prior art discloses authentication of local/resident software. By validating local information such as id, authenticity is determined (see Dictionary of Computing, "authentication", copy included).

Applicant argues claims 21 and 22 overcome the 101 rejection to software and signals. This is not persuasive. The claim language does not lay claim to the loading or the computing device. The language recites a “means for providing ...”. This means covers at least software alone. Further, a CPU “load” instruction would be software and provides a means for loading. Applicant’s Specification defines statutory and non-statutory mediums. Applicant’s claims lay claim to both.

These issues are believed to clarify all of Applicant’s concerns and as such the claims remain rejected under the cited prior art.

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***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 10:00am - 4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571)-272-3756. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

/William H. Wood/  
William H. Wood  
Primary Examiner, Art Unit 2193  
May 5, 2008

<b>Office Action Summary</b>	<b>Application No.</b> 09/698,526	<b>Applicant(s)</b> VASSILOVSKI ET AL.	
	<b>Examiner</b> William H. Wood	<b>Art Unit</b> 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |